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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,136	04/17/2000	WINFRIED JENTSCH	2694-124PCT	5896

2292 7590 03/08/2002

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

FORMAN, BETTY J

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 03/08/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/463,136

Applicant(s)

JENTSCH ET AL.

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 February 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ they raise the issue of new matter (see Note below);  
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached Continuation of Advisory Action.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 20-37.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☒ Other: Continuation of Advisory Action

CONTINUATION OF ADVISORY ACTION

1. This action is in response to papers filed 27 February 2002 in Paper No. 13 in which claims 22 and 22-36 were amended. The amendments have not been entered because they potentially raise the issue of new matter because Applicant has not pointed to the specification for support of the newly added "non-liquid" limitation. Additionally, they have not been entered because they do not reduce or simplify the issues presented in the Office Action of Paper No. 10, dated 27 June 2001. The amendments, if entered, would overcome the rejections under 35 U.S.C. 112, second paragraph. The amendments are further discussed below. The previous rejections in the Office Action of Paper No. 10 are maintained.

**Response to Arguments**

2. Applicant argues that the "objects which are contained in a liquid" clarifies that the objects are not liquid themselves and therefore the droplets of Balch do not anticipate the instant claims. The argument has been considered but is not found persuasive because while the droplets of Balch are liquid, they contain non-liquid matter i.e. capture probes encompassing nucleic acids, ligands, antibodies, antigens, proteins and chemical compounds (Column 8, lines 21-27) wherein the non-liquid capture probes are present in a concentration suitable for deposit (Column 9, lines 40-45). Therefore, the liquid droplets deposited by Balch contain non-liquid objects.

3. Applicant further argues that micro-balls of Lough et al would be inoperable in the ink-jets of Balch. The argument has been considered but is not found persuasive because the claims do not recite any size limitations or exclusions for either the depositors or non-liquid

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objects. Therefore the arguments do not address the arguments do not address limitations within the claims.

**Conclusion**

4. The examiner's Art Unit has changed from 1655 to 1634. Please address future correspondence to Art Unit 1634.
5. No claim is allowed.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:30 TO 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
BJ Forman, Ph.D.  
Patent Examiner  
Art Unit: 1634  
March 6, 2002

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600